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EXAMINER

WALLERSON, MARK E

| ART UNIT | PAPER NUMBER |
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2622

DATE MAILED: 07/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/848,456

Applicant(s)
Barry et al

Examiner
Mark Wallerson

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2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 1-31 are pending.

Double Patenting

2. Claims 1-31 of this application conflict with claims 1-31 of Application No. 09/044,539. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-31 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-31 of copending Application No. 09/044,539. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. **Claims 9, 20, and 31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claims 9, 20, and 31** recite the limitation "the printed test pages" in lines 11 and 12 of **claim 9**, lines 12 and 13 of **claim 20**, and lines 11 and 12 of **claim 31**. There is insufficient antecedent basis for this limitation in the claim. Lines 4, 5, and 7 of **claim 9**, lines 5, 6, and 8 of **claim 20**, and lines 4, 5, and 7 of claim 31 refer to **a/the** test page.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claim 1, 5, 6, 7, 8, 12, 16, 17, 18, 19, 21, 25, 26, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Springett (U. S. 5,636,032).

With respect to **claim 1**, Springett discloses a method for determining toner usage for a document comprising the steps of determining the number of pixels that are on in at least one page of the document (column 3, lines 29-32 and 41-42 and column 5, lines 26-29); comparing the number of pixels that are on to a predetermined toner usage for a defined number of pixels that are on in a reference page (which reads on comparing the percentage coverage on the page to the toner or ink coverage of a 8.5" x 11" page that has a theoretical number of pixels) (column 4, lines 10-19), and calculating the amount of toner utilized by the at least one page as a proportion of that used by the reference page (column 4, lines 10-19 and column 3, lines 61-64).

With respect to **claim 5**, Springett discloses that the defined number of pixels are all pixels for the reference page (which reads on the theoretical number of pixels for a 8.5" x 11" page is 15,000,000) (column 4, lines 10-19).

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With respect to **claim 6**, Springett discloses printing the document with a marking engine after the calculating step (which reads on printing with a raster output scanner after calculating the toner usage) (column 3, lines 24-35 and column 2, lines 39-50).

With respect to **claim 7**, Springett discloses rasterizing the document of at least one page into a rasterized image (column 4, lines 3-6), and determining the number of pixels determining the number of pixels that are on in the rasterized image of the page (which reads on the area coverage) (column 4, lines 3-6 and column 5, lines 26-35).

With respect to **claim 8**, Springett discloses storing the rasterized (rendered) image (column 4, lines 6-9).

With regard to **claim 12**, Springett discloses a method for determining toner usage for a multicolor document (column 5, lines 48-50) having different color panes (which reads on having individual color inks) (column 5, lines 50-54) comprising the steps of determining the number of pixels that are on in at least one page of the document in a given pane (column 5, lines 61-66); comparing the number of pixels that are on to a predetermined toner usage for a defined number of pixels that are on in a reference page (which reads on comparing the percentage coverage for each color on the page to the toner or ink coverage of a 8.5" x 11" page that has a theoretical number of pixels) (column 4, lines 10-19 and column 5, lines 61-66), and calculating the amount of toner utilized by the at least one page as a proportion of that used by the reference page (column 5, line 55 to column 6, line 7; column 4, lines 10-19, and column 3, lines 61-64).

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With respect to **claim 16**, Springett discloses that the defined number of pixels are all pixels for the reference page (which reads on the theoretical number of pixels for a 8.5" x 11" page is 15,000,000) (column 4, lines 10-19).

With respect to **claim 17**, Springett discloses printing the document with a marking engine after the calculating step (which reads on printing with a raster output scanner after calculating the toner usage) (column 3, lines 24-35 and column 2, lines 39-50).

With respect to **claim 18**, Springett discloses rasterizing the document of at least one page into a rasterized image (column 4, lines 3-6), and determining the number of pixels determining the number of pixels that are on in the rasterized image of the page (which reads on the area coverage) (column 4, lines 3-6 and column 5, lines 26-35).

With respect to **claim 19**, Springett discloses storing the rasterized (rendered) image (column 4, lines 6-9).

With respect to **claim 21**, Springett discloses a method for determining toner usage for a multi-page document (which reads on a job) (column 4, lines 32-33 and 66-67) comprising the steps of determining the number of pixels that are on in at least one page of the document (column 3, lines 29-32 and 41-42 and column 5, lines 26-29); comparing the number of pixels that are on to a predetermined toner usage for a defined number of pixels that are on in a reference page (which reads on comparing the percentage coverage on the page to the toner or ink coverage of a 8.5" x 11" page that has a theoretical number of pixels) (column 4, lines 10-19), and

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calculating the amount of toner utilized by the at least one page as a proportion of that used by the reference page (column 4, lines 10-19 and column 3, lines 61-64).

With respect to **claim 25**, Springett discloses that the defined number of pixels are all pixels for the reference page (which reads on the theoretical number of pixels for a 8.5" x 11" page is 15,000,000) (column 4, lines 10-19).

With respect to **claim 26**, Springett discloses printing the document with a marking engine after the calculating step (which reads on printing with a raster output scanner after calculating the toner usage) (column 3, lines 24-35 and column 2, lines 39-50).

With respect to **claim 27**, Springett discloses rasterizing the document of at least one page into a rasterized image (column 4, lines 3-6), and determining the number of pixels determining the number of pixels that are on in the rasterized image of the page (which reads on the area coverage) (column 4, lines 3-6 and column 5, lines 26-35).

With respect to **claim 28**, Springett discloses storing the rasterized (rendered) image (column 4, lines 6-9).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. **Claims 10 and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by Beck (U. S. 5,760,795).

With respect to **claim 10**, Beck discloses a method for determining toner usage (which reads on low material marking status) comprising the steps of rasterizing an input data file into input pages (column 3, lines 44-53); determining the amount of toner to be disposed on each page prior to printing the page by determining the pixel percentage in a given rasterized image (column 5, lines 25-40); printing the image (column 6, lines 20-28), and decrementing a toner value by a defined amount associated with the determined toner for the given page (which reads on updating the amount of marking material after making a hard copy of the transmitted image) (column 6, 36-42).

With regard to **claim 11**, Beck discloses receiving a multi-page document (column 4, lines 14-23), determining the amount of toner for the entire document prior to printing (column 5, lines 30-34), then determining if sufficient toner is available in the toner module (column 4, lines 19-22), and inhibiting printing if the toner density value is less than the determined amount of toner for the multi-page document (column 4, lines 33-42).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 2, 3, and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Springett in view of Beck (U. S. 5,760,795).

With regard to **claim 2**, Springett discloses determining the number of pixels that are on in at least one page of the document (column 3, lines 29-32 and 41-42 and column 5, lines 26-29); comparing the number of pixels that are on to a predetermined toner usage for a defined number of pixels that are on in a reference page (which reads on comparing the percentage coverage on the page to the toner or ink coverage of a 8.5" x 11" page that has a theoretical number of pixels) (column 4, lines 10-19).

Springett differs from **claim 2** in that he does not clearly disclose that a pixel in the at least one page can be partially on. Beck discloses a system for determining a low toner level in which the number of grey scale pixels (which reads on pixels that are partially on) are counted (column 5, lines 27-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Springett wherein some pixels in the at least one page can be partially on. It would have been obvious to one of ordinary skill in the art at the time of the

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invention to have modified Springett by the teaching of Beck in order to determine the amount of marking material that would be required to print the documents as disclosed by Beck in column 5, lines 30-33.

With respect to **claim 3**, Springett discloses that the defined number of pixels are pixels for the reference page (column 4, lines 10-19), and are on to a defined percentage (column 4, lines 17-19).

With regard to **claim 4**, Springett discloses that the defined percentage is one hundred percent (which reads on the theoretical number of pixels for an 8.5" x 11" page being 15,000,000) column 4, lines 10-19).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 13, 14, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Springett in view of Beck (U. S. 5,760,795).

With respect to claim 13, Springett discloses a method for determining toner usage for a multicolor document (column 5, lines 48-50) having different color panes (which reads on having individual color inks) (column 5, lines 50-54) comprising the steps of determining the number of

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pixels that are on in at least one page of the document in a given pane (column 5, lines 61-66); comparing the number of pixels that are on to a predetermined toner usage for a defined number of pixels that are on in a reference page (which reads on comparing the percentage coverage for each color on the page to the toner or ink coverage of a 8.5" x 11" page that has a theoretical number of pixels) (column 4, lines 10-19 and column 5, lines 61-66).

Springett differs from **claim 13** in that he does not clearly disclose that a pixel in the at least one page can be partially on. Beck discloses a system for determining a low toner level in which the number of grey scale pixels (which reads on pixels that are partially on) are counted (column 5, lines 27-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Springett wherein some pixels in the at least one page can be partially on. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Springett by the teaching of Beck in order to determine the amount of marking material that would be required to print the documents as disclosed by Beck in column 5, lines 30-33.

With respect to **claim 14**, Springett discloses that the defined number of pixels are pixels for the reference page (column 4, lines 10-19), and are on to a defined percentage (column 4, lines 17-19).

With regard to **claim 15**, Springett discloses that the defined percentage is one hundred percent (which reads on the theoretical number of pixels for an 8.5" x 11" page being 15,000,000) column 4, lines 10-19).

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16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 22, 23, 24, and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Springett in view of Beck (U. S. 5,760,795).

With respect to **claim 22**, Springett discloses a method for determining toner usage for a multi-page document (which reads on a job) (column 4, lines 32-33 and 66-67) comprising the steps of determining the number of pixels that are on in at least one page of the document (column 3, lines 29-32 and 41-42 and column 5, lines 26-29); comparing the number of pixels that are on to a predetermined toner usage for a defined number of pixels that are on in a reference page (which reads on comparing the percentage coverage on the page to the toner or ink coverage of a 8.5" x 11" page that has a theoretical number of pixels) (column 4, lines 10-19).

Springett differs from **claim 22** in that he does not clearly disclose that a pixel in the at least one page can be partially on. Beck discloses a system for determining a low toner level in which the number of grey scale pixels (which reads on pixels that are partially on) are counted (column 5, lines 27-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Springett wherein some pixels in the at least one page can be partially on. It would have been obvious to one of ordinary skill in the art at the time

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of the invention to have modified Springett by the teaching of Beck in order to determine the amount of marking material that would be required to print the documents as disclosed by Beck in column 5, lines 30-33.

With respect to **claim 23**, Springett discloses that the defined number of pixels are pixels for the reference page (column 4, lines 10-19), and are on to a defined percentage (column 4, lines 17-19).

With regard to **claim 24**, Springett discloses that the defined percentage is one hundred percent (which reads on the theoretical number of pixels for an 8.5" x 11" page being 15,000,000) column 4, lines 10-19).

With respect to **claim 29**, Beck discloses receiving a multi-page document (column 4, lines 14-23), determining the amount of toner for the entire document prior to printing (column 5, lines 30-34), then determining if sufficient toner is available in the toner module (column 4, lines 19-22), and printing only the pages that would equal the available toner (column 4, lines 32-37).

Allowable Subject Matter

18. **Claim 30** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The following is an examiner's statement of reasons for allowance: The prior art of record does not disclose teach or suggest the claimed limitations of (in combination with all other

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limitations in the claim) determining the available toner by initiating a counter at a first known toner level for a print engine, decrementing the counter by the determined toner requirement of a document, and subtracting from the counter a known minimum toner value that defines a toner empty condition, this value defined as the available toner level as claimed in claim 30.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

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(703) 308-9589 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington. VA.

Sixth Floor (Receptionist)


MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson